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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:

Serial No. 10/612,504
Inventors: SHANKS, Steven C. and TUCEK, Kevin B.
Invention: Multi-Probe Device
Filing Date: 07/01/2003
Atty Docket No.: 206-038

CERTIFICATE OF EXPRESS MAILING

I hereby certify that the following correspondence is being deposited with the United States Postal Service as EXPRESS MAIL, postage paid, in an envelope addressed to: Director of U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on :

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Sandra L. Etherton

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**PETITION TO DISPUTE EXAMINER'S RELIANCE
ON SEPTEMBER APPEAL BRIEF**

Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition under 37 CFR §§ 1.181 and 1.182 disputing the Examiner's reliance on a now-moot Appeal Brief filed by the Applicants on September 27, 2007. This petition is filed within the stated two month period of 37 CFR §1.181(f) and is therefore considered timely filed. A charge form for the \$400 filing fee for this Petition is enclosed.

Summary

Due to a series of disputes, Applicants have filed four appeal briefs in their appeal: the August Brief, March Brief, June Brief, and September Brief. Only the March Brief addresses all of the pending appealable rejections. Unfortunately, the Examiner has prepared his Answer to the wrong brief. Accordingly, Applicants request that the Examiner's Answer responding to the September Brief be withdrawn and that a new Examiner's Answer be issued that responds to the March Brief.

Transaction Summary

The procedural aspects of this case are complicated. This section summarizes the dates and reasons the four appeal briefs were filed, but a more detailed explanation of the substantive issues follows below. A printout from PAIR shows the transaction record at Exhibit AA, which may more clearly illustrate which brief Applicants believe should be answered by the Examiner.

The first appeal brief was filed on August 2, 2006 (August Brief) along with Applicants' original Notice of Appeal. The second appeal brief was filed on March 5, 2007 (March Brief) along with Applicants' Petition to Revive the Appeal. The third appeal brief was filed on June 29, 2007 (June Brief) in response to a June 5, 2007 Notice of Non-Compliant Brief, while awaiting a decision from the Director on Applicants' petition disputing the June Notice of Non-Compliant Brief. The fourth appeal brief was filed on September 27, 2007 (September Brief) to correct the signature on the June Brief. The September Brief replaces the June Brief.

On September 14, 2007, the Director granted Applicants' petition to withdraw the June 5, 2007 Notice of Non-Compliant Brief that rejected the March Brief. Accordingly, the March Brief *is* compliant and pending, and the September Brief is moot. The Examiner, however, has responded to the September Brief rather than the March Brief in his Examiner's Answer. Applicants request that the Examiner's Answer be withdrawn and a new Answer be written in response to the currently pending March Brief.

Detailed Statement of Facts Pertinent to this Petition

In a final office action dated November 10, 2005, among other rejections, the Examiner rejected Applicants' claims 3-7, 16-22 and 23-29 as being obvious over U.S. Patent 6,074,411 issued to Lai et al. ("Lai") in light of U.S. Patent 6,267,779 issued to Gerdes ("Gerdes").¹ Applicants responded to the final office action with arguments and proposed amendments on March 8, 2006. The Examiner issued an advisory action on March 29, 2006, rejecting Applicants' proposed amendments without addressing Applicants' arguments.

Applicants filed a Notice of Appeal and on August 2, 2006, Applicants filed an Appeal Brief (hereinafter "August Brief") that included arguments directed toward the Examiner's obviousness rejections citing Lai and Gerdes from his November 10, 2005 Final Office Action.²

¹ November 10, 2005, Final Office Action, pp. 4-5, attached hereto as Exhibit A.

² See August 2, 2006 Appeal Brief, pp. 23-34, attached hereto without appendices as Exhibit B.

On September 28, 2006, the Examiner reopened prosecution and issued a new office action citing a new ground for rejection.³ With respect to Applicants' arguments addressing the Examiners' earlier obviousness rejection over Lai in view of Gerdes, the Examiner stated:

Applicant's Appeal Brief filed August 2, 2006 is acknowledged. Prosecution on the merits of this application is reopened and the finality of the office action of November 10, 2005 is withdrawn. *Lai et al. teach a specific embodiment without an adhesive ring (Fig. 2) that is clearly capable of being freely moved by a hand while radiating. Lai et al. therefore does not teach away from moving the wand by hand.* A new office action is provided herein.,,

Id., p. 2 (emphasis added).

In response to the Examiner's new office action, Applicants filed a Petition to Revive the Appeal and on March 5, 2007 submitted a new Supplemental Appeal Brief (hereinafter "March Brief"), which incorporates by reference the earlier August Brief. The March Brief addresses the new rejection made by the Examiner as well as the Examiner's earlier obviousness rejections citing Lai and Gerdes, specifically including claims 23-29.⁴ The March Brief addresses all of the pending appealable rejections.

The Examiner rejected the March Brief stating that his earlier obviousness rejections citing Lai and Gerdes were no longer appropriate for the appeal because they were not part of the Examiner's most recent office action.⁵ In response, Applicants disputed the Examiner's rejection of the March Brief and filed, in an abundance of caution, a Revised Supplemental Appeal Brief (hereinafter "June Brief") and subsequently a Signed Revised Supplemental Appeal Brief (hereinafter "September Brief") correcting and replacing the June Brief.⁶ The September Brief replaces the June Brief and, apart from the signature, is identical to the June Brief. The petition was granted on September 14, 2007, and the Notification of Non-Compliant Brief was withdrawn.⁷ Consequently, the March Brief is pending.

In the Decision on Petition, the Director specifically directs the Examiner to "in his next office action or by a separate letter to expressly state the reason for withdrawal of the rejections

³ See September 28, 2006 Office Action, attached hereto as Exhibit C.

⁴ See March 5, 2007 Appeal Brief, p. 15 (incorporating by reference August 2, 2006 Supplemental Appeal Brief, pp. 30-34).

⁵ See June 5, 2007 Notification of Non-Compliant Appeal Brief, attached hereto as Exhibit E.

⁶ See September 27, 2007 Revised Supplemental Appeal Brief (identical to and correcting signature of June 29, 2007 Revised Supplemental Appeal Brief), attached hereto without appendices as Exhibit F; Petition to Dispute the Notification of Non-Compliant Appeal Brief, attached hereto without exhibits as Exhibit G.

⁷ See September 14, 2007 Decision on Petition, attached hereto as Exhibit H.

of claims 3-7 and 16-22 under 35 U.S.C. 103(a) as being unpatentable over Lai et al. in view of Gerdes in accordance with the MPEP 707.07(f).” *Id.* The Director did not address the obvious rejection of Applicants’ claims 23-29 over Lai in view of Gerdes. *Id.* Likewise, in the Examiner’s letter of explanation he only withdrew his obviousness rejection over Lai in view of Gerdes with respect to Applicants’ claims 3-7 and 16-22.⁸ Specifically, the rejection was not withdrawn with respect to Applicants’ claims 23-29. *Id.*

On November 1, 2007, the Examiner issued an Examiner’s Answer.⁹ In the Answer, however, the Examiner responded to the September Brief that was filed while awaiting a decision on the Petition. *Id.*, p. 1. Because the Notice of Non-Compliant Brief was withdrawn, however, Applicants’ believe that the September Brief is moot, and the March Brief is pending. Only the March Brief includes Applicants’ arguments regarding the still pending obviousness rejections citing Lai and Gerdes directed to Applicants’ claims 23-29.

Point to be Reviewed

March Brief is Pending

At issue is whether the Examiner erroneously responded to a moot appeal brief. According to the Director’s Decision on Petition, the June 5, 2007 Notification of Non-Compliant Appeal Brief was withdrawn. Because the Notification of Non-Compliant Appeal Brief was withdrawn, the March Brief is compliant. Because the March Brief was compliant, it should be the pending brief and consequently the brief to which the Examiner should respond. Accordingly, the Examiner responded to the wrong brief in his Examiner’s Answer.

Only March Brief Covers All Appealable Issues, Including Claims 23-29

Also at issue is whether the Examiner accepted as persuasive Applicants’ arguments that their claimed invention, as recited in Applicants’ claims 23-29, is not obvious over Lai in view of Gerdes. According to the MPEP, “[i]f applicant’s arguments are persuasive and upon reconsideration of the rejection, the examiner determines that the previous rejection should be withdrawn, the examiner *must* provide in the next Office communication the reasons why the

⁸ See September 24, 2007 Communication from the Examiner, attached hereto as Exhibit I.

⁹ See November 1, 2007 Examiner’s Answer, attached hereto as Exhibit J.

previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the rejection." MPEP §707.07 (emphasis added).

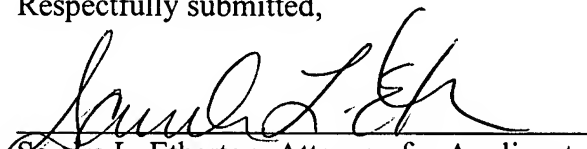
The Examiner did not state that any of Applicants' arguments were persuasive in his September 28, 2006, Office Action. Likewise, the Examiner did not state that Applicants' arguments were persuasive with respect to claims 23-29 in his September 24, 2007 Communication. The Examiner only withdrew his obviousness rejections with respect to Applicants' claims 3-7 and 16-22. Without any express assertions to the contrary, Applicants must be prudent and assume that the Examiner has neither accepted Applicants' arguments nor withdrawn the obviousness rejection of claims 23-29 over Lai in view of Gerdes. Only the March Brief addresses this matter.

Accordingly, whether the Examiner rightfully determined that Applicants' claimed invention, as recited in claims 23-29, is obvious over Lai in view of Gerdes remains a matter for review by the Board of Patent Appeals and Interferences. Moreover, the September Brief was filed in response to a now-withdrawn Notice of Non-Compliant Brief, so the March Brief is pending. Consequently, the Examiner erred in responding to Applicants' September Brief.

Action Requested

Because the Examiner never affirmatively withdrew his obviousness rejections based on the combination of Lai and Gerdes with respect to claims 23-29 and because the Notification of Non-Compliant Brief was withdrawn, Applicants respectfully submit that their March Brief is properly pending and covers all appealable rejections. Accordingly, Applicants request that the Examiner's Answer responding to the September Brief be withdrawn and that a new Examiner's Answer be issued that properly responds to the March Brief.

Respectfully submitted,


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